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No. 95-1721

IN THE
Supreme Court of the United States
October Term 1995

IMAZIO NURSERY, INC.,
Petitioner,

v.

COASTAL NURSERY, JESS RODRIGUES, and DONNA RODRIGUES,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE NATIONAL ASSOCIATION OF PLANT PATENT OWNERS IN SUPPORT OF PETITIONER

Of Counsel:
Stephen A. Bent
Michael D. Kaminski
Richard C. Peet
FOLEY & LARDNER
3000 K Street, N.W.
Suite 500
Washington, D.C. 20007
(202) 672-5300

Donald D. Jeffery
FOLEY & LARDNER
3000 K Street, N.W.
Suite 500
Washington, D.C. 20007
(202) 672-5300

Counsel for Amicus Curiae National Association of Plant Patent Owners

QUESTIONS PRESENTED

Amicus curiae National Association of Plant Patent Owners (NAPPO) adopts questions (1) and (2) presented by Petitioner Imazio:

> (1) Does the scope of protection afforded by a plant patent pursuant to 35 U.S.C. § 161 (1994) extend to all plants within a new and distinct taxonomical variety of plant or is it limited to a single plant and its genetically identical progeny?
>
> (2) Is the proper test for plant patent infringement whether the accused plant is genetically identical to the patented plant or whether the accused plant belongs to the same taxonomical variety, *i.e.*, has the same essential characteristics, as a patented plant?

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BRIEF OF AMICUS CURIAE NATIONAL ASSOCIATION OF PLANT PATENT OWNERS IN SUPPORT OF A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

This *amicus curiae* brief is submitted to support the petition for a writ of certiorari. Both Petitioner ("Imazio") and Respondents ("Coastal") have consented in writing to the filing of this brief.

INTEREST OF THE AMICUS

NAPPO is a national trade association representing U.S. plant patent holders and others interested in breeding, selecting, and introducing new varieties of asexually reproduced plants. NAPPO presently has 72 members, comprising some of the nation's foremost breeders supplying the United States agricultural industry with new plant varieties.

NAPPO's members apply for, receive, and enforce a comparatively large number of the plant patents issued each year. Accordingly, NAPPO's members have a direct stake in the scope of protection afforded under the Plant Patent Act.

SUMMARY OF THE ARGUMENT

The Federal Circuit's decision below has significant ramifications beyond the parties involved. The decision renders a narrow interpretation of 35 U.S.C. § 163, limiting plant patent protection to exact duplication of the patented plant. This interpretation diminishes the value of plant patents, both now and in the future.

Moreover, the Federal Circuit's interpretation diminishes incentives for plant developers to cultivate new plant innovations. It also discourages developers from publicly disclosing their new plant discoveries. The result is a significant economic impact on this nation's agricultural industry, which relies on plant patent protection.

In addition, the Federal Circuit's interpretation fails to carry out Congress' intent that the Plant Patent Act place plant developers on equal footing with those obtaining patents in other industries. Plant patents would stand alone as the only type of patent for which protection does not extend beyond the exact patented embodiment.

In the coming term, this Court will consider the analogous issue of the scope of protection offered by utility patents beyond the literal language of the claims, in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995) (*en banc*), *cert. granted*, 116 S. Ct. 1014 (1996). Because both cases concern the scope of protection afforded to a patent claim beyond its literal scope, they should be decided together.

Finally, Imazio's petition in this case presents the ideal opportunity for this Court to offer its guidance on the proper interpretation of the Plant Patent Act. There is no need to consider any of the technical aspects of the particular patent in suit.

For the reasons given herein, it is respectfully requested that the petition for writ of certiorari be granted.

REASONS FOR GRANTING THE PETITION

I. This Court Should Exercise Its Supervisory Authority Over the Federal Circuit to Ensure that the Plant Patent Act is Properly Interpreted

This Court should exercise its supervisory authority in the instant case for two reasons. First, the Federal Circuit's decision has significant ramifications beyond the parties involved. The Federal Circuit's interpretation of 35 U.S.C. § 163 substantially impacts the scope of protection afforded by a plant patent pursuant to 35 U.S.C. § 161.

Second, in the coming term this Court will consider the scope of protection afforded to a patent claim beyond the literal scope of that claim, in *Hilton Davis* (a utility patent claim interpreted). Analogously, this case concerns the scope of protection afforded beyond the exact subject matter in the plant patent claim.

Third, although the Plant Patent Act plays a significant role in the success of the United States agricultural industry, only a handful of courts have interpreted the Act, including the Federal Circuit's decision below. Further, this Court has never substantively addressed the scope of protection under the Plant Patent Act. This Court's guidance, therefore, would be of great value to those who rely on it to protect their agricultural innovations.

II. The Federal Circuit's Interpretation of the Plant Patent Act Severely Diminishes the Intended Benefits of Plant Patents

The Federal Circuit's interpretation of the Plant Patent Act diminishes incentives for developing new plant varieties. It also diminishes incentives for plant developers to publicly disclose, in patent applications, how to make their new varieties. As a result, the agricultural industry is significantly affected.

A. The Federal Circuit's Interpretation Undermines Incentives to Develop and Publicly Disclose New Plant Innovations

Congress' power to grant patents to "promote the Progress of Science and useful Arts" derives from the Constitution itself. Art. I, § 8, cl. 8. Congress carried out this mandate by enacting the patent laws, which promote progress by offering inventors exclusive rights for a limited time as an incentive for their innovation and research effort. *See Diamond v. Chakrabarty*, 447 U.S. 303, 307 (1980) (citing *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480-81 (1974); *Universal Oil Prods. Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944)).

This Court has also acknowledged the benefits of providing such incentives. In *Kewanee Oil*, this Court stated

that Congress intended the patent laws to "have a positive effect on society through the introduction of new products and processes of manufacture into the economy, and the emanations by way of increased employment and better lives for our citizens." 416 U.S. at 480. In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, this Court further recognized that patents provide the "building blocks of further innovation" by "bring[ing] new designs and technologies into the public domain through disclosure." 489 U.S. 141, 151 (1989).

Until 1930, the patent laws recognized two distinct types of patents: (a) utility patents, currently codified at 35 U.S.C. § 100 *et seq.*; and (b) design patents, currently provided for at 35 U.S.C. §§ 171-173. Both types offer incentives for innovation and research efforts.

In 1930, Congress enacted the Townsend-Purnell Plant Patent Act ("the Plant Patent Act" or "the Act"). The Act's intent was to similarly provide incentives to plant breeders or discoverers to develop new plant varieties. As the Senate Committee Report to the Act stated,

> The bill . . . proposes to afford through patent protection an incentive to asexually reproduce new varieties. Many varieties of apples equally as valuable as the McIntosh or Greening have undoubtedly been created and disappeared beyond human power of recovery because no attempt was made to asexually reproduce the new varieties. The present bill by its patent protection proposes to give the necessary incentive to preserve new varieties.

S. Rep. No. 315, 71st Cong., 2d Sess. 4 (1930) ("Senate Report") (PA 80).

The Federal Circuit's decision below takes away those incentives to discover and exploit new plant variations, by severely limiting the value of plant patents. It does so by limiting the protection afforded by the plant patent and thereby allowing others to circumvent liability. To the extent that a developer cultivates a plant that achieves commercial success, others will attempt to emulate it. But under the Federal Circuit's interpretation, the Plant Patent Act provides no exclusivity against such emulations unless they are genetically identical to the patented plant itself. In other words, the infringing plants must originate from the same plant depicted in the plant patent. Without the ability to protect the plant invention against non-identical plants having the same essential characteristics as the patented plant, the patent owner obtains very little in exchange for the research efforts in cultivating, exploiting, and patenting its new variety.

Similarly, the inventor has little incentive to bring his invention into the public domain through the patent disclosure. This Court has recognized that "the ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure." *Bonito Boats*, 489 U.S. at 151. Like the other forms of patents, attaining a plant patent requires the inventor to fully disclose his

invention.[1] The inventor must provide (1) a written description of the claimed invention, (2) the manner of making and using the invention, and (3) the best mode for carrying out the invention. 35 U.S.C. § 112 (1994).

These disclosure requirements necessitate a description of how the new variety was obtained and the conditions for its asexual propagation. For example, if the new variety was obtained by means of a sexual cross, the parents must be identified. Alternatively, if the new variety was obtained by mutagenesis, the conditions of mutation induction and plant material from which the mutant was selected must be disclosed. Consequently, the inventor provides the public with a road map which describes how to achieve the new plant variety. Publicly disclosing this information in the plant patent therefore aids competitors in achieving substantially similar plant varieties sharing the same essential characteristics as the patented plant.

Under the Federal Circuit's interpretation, the patent owner receives only limited protection in return for placing the invention into the public domain. Because of the limited reach afforded by the Federal Circuit's interpretation, the scope of protection under the plant patent statute curbs rather than promotes incentives to develop and publicly disclose new plant innovations.

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[1] Congress recognized that it is difficult to satisfy the written description requirements under 35 U.S.C. § 112 for innovations in the plant arena. As a result, 35 U.S.C. § 162 provides that a plant patent shall provide a description that is "as complete as is reasonably possible."

B. The Federal Circuit's Decision Has a Significant Economic Impact on the Agricultural Industry Beyond the Parties Involved

This nation's agricultural industry relies on the protection afforded by the Plant Patent Act. Developers of fruit varieties, such as strawberries or apples, and horticultural plants utilize plant patents to protect their innovations. More than 9500 plant patents have issued since the enactment of the Plant Patent Act. *See generally*, American Association of Nurserymen, *Plant Patent Directory* 1 (1989 & Supps. 1990-95). Since 1990, an average of 390 plant patents have been issued per year, comprising a broad array of new plant varieties. *Id.* These new varieties offer consumers the benefit of, *inter alia*, new colors, forms, flavors, growth rates and habits, pest resistance, environmental tolerance, and other desirable traits.

According to the United States Department of Agriculture, nursery and greenhouse grower cash receipts from sale of plants totaled an estimated $10.04 billion in 1994, representing nearly eleven percent of the total cash receipts for all U.S. farm crops. *Doyle C. Johnson, U.S. Greenhouse & Nursery Industry Flourishes, in Agricultural Outlook*, Economic Research Service, United States Department of Agriculture 26-28 (Sept. 1995). At the retail level, consumer expenditures for nursery and greennouse

plants were estimated by the Department of Agriculture to be $44.6 billion in 1994. *Id.* Given these numbers, even a "small" effect would have significant economic consequences.

III. The Legislative History and Purpose of the Plant Patent Act Indicates Congress' Intent to Place Plant Developers on Equal Footing With Those in Other Industries

In enacting the Plant Patent Act, Congress intended to extend patent protection to the agricultural industry as it had provided to other industries. The legislative history accompanying the Act indicates that:

> The purpose of the bill is to afford agriculture, so far as practicable, the same opportunity to participate in the benefits of the patent system as has been given industry, and thus assist in placing agriculture on a basis of economic equality with industry. The bill will remove existing discrimination between plant developers and industrial inventors.

Senate Report (PA 74-75).

That Congress meant plant patent protection to be equal to the other two forms of patents is further evident in

the Patent Act of 1952.[2] Although separate from the utility and design patent sections, the plant provisions explicitly provide that "[t]he provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided." 35 U.S.C. § 161 (1994). The Federal Circuit itself recognized in the opinion below that § 161 requires applying to the plant patent sections "'all the rules, regulations, and provisions of the basic patent law,' except as otherwise provided." (PA 9) (quoting *In re LeGrice*, 301 F.2d 929, 933 (C.C.P.A. 1962)).

Unfortunately, the Federal Circuit's decision does not make plant patents equal. Plant patents would stand alone in that the scope of protection thereof would not extend to substantially similar inventions. Both design and utility patents afford protection against embodiments that are substantially similar to, though not exactly the same as, the claimed invention.

Turning to design patents, they offer protection to designs beyond that which is exactly depicted therein. This Court's own precedent established the doctrine that design patents cover competing embodiments that are either identical to or substantially the same as the patented invention. In *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871), this Court interpreted the original Design

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[2] As originally enacted, the provisions for plant patent protection were instituted as amendments to the general patent law. Rev. Stat. § 4884, as amended by Act of May 23, 1930, ch. 312, § 1, 46 Stat. 376. The Patent Act of 1952 places the plant patent provisions in 35 U.S.C. §§ 161-164 (1988). Act of July 19, 1952, ch. 950, 66 Stat. 804.

Patent Act of 1842[3] and held that a design substantially similar to the patented design may infringe:

> [I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are *substantially* the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

Id. (emphasis added). This is still the fundamental test for design patent infringement. *See Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1190 (Fed. Cir. 1988) (noting that in light of the *Gorham* test, "infringement can be found for designs that are not identical to the patented design").

Implicit in *Gorham* is the observation that a patent has little value if it only protects against products that are identical to the patented invention. This implication similarly applies to plant patents, *i.e.*, a plant patent has little value if only restricted to clones of the patented plant.

As for utility patents, this Court has long recognized a similar doctrine, that the scope of protection afforded to claims in utility patents can go beyond their literal scope. *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853). This Court's most recent guidance on the doctrine, rendered in the decision of *Graver Tank & Manufacturing Co. v. Linde*

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[3] Act of August 29, 1842, ch. 263, § 2, 5 Stat. 543. Presently, the design patent provisions can be found at 35 U.S.C. §§ 171-173.

Air Products Co., reemphasized the importance of providing patent protection for devices falling outside the literal words of the claims. 339 U.S. 605 (1950). In *Graver Tank*, Justice Jackson recognized that "[o]utright and forthright duplication is a dull and very rare type of infringement." *Id.* at 607. Justice Jackson further noted that to prohibit none other than literal infringement would deprive the inventor of his invention and "foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system." *Id.*

As this Court recognized in *Graver Tank*, a patent for which protection is restricted to exact copies deprives the inventor of the full value of his invention. The policy of *Graver Tank* applies to plant patents as well. Plant developers spend significant sums to cultivate and exploit new plant varieties. To allow competitors to freely propagate substantially similar variations of a patented plant will discourage plant developers from patenting their newly found discoveries. As a result, inventors will be encouraged to conceal their inventions rather than disclosing them.

Besides *Graver Tank*, this Court has recently granted certiorari in *Hilton Davis* to address, at least in part, the extent to which utility patents provide protection against devices and processes outside the "literal" language in the patent's claims. Both *Hilton Davis* and this case concern the scope of infringement afforded beyond the subject matter of the patent claims.

Congress intended the Plant Patent Act to provide plant developers protection on equal footing with their industrial counterparts, namely, utility and design patents. As such, this Court's consideration of the scope of infringement in *Hilton Davis* may impact the proper interpretation of the Plant Patent Act. In view of the relevance of *Hilton Davis* to the questions presented in the instant case, this Court should exercise its supervisory authority to hear these two cases in the same term.

IV. The Petition Presents an Ideal Opportunity to Decide the Issue

The present case presents an ideal opportunity for deciding this fundamental issue of patent policy and statutory construction.

First, evaluating the proper scope of protection under the Plant Patent Act is the only issue raised by Petitioner and *amicus*. No evaluation of the technology in the particular patent-in-suit will be necessary.

Second, the effect on the agricultural industry is real. That industry relies on plant patents to protect rights in plant discoveries and innovations. The Federal Circuit's narrow interpretation of the Plant Patent Act affects the future value of the research monies spent within this important sector of the economy.

Evaluation of the scope of protection under the Plant Patent Act is therefore abundantly ripe for review.

CONCLUSION

This Court should grant Petitioner's request for a writ of certiorari to review the Federal Circuit's interpretation of the scope of protection under the Plant Patent Act.

Respectfully submitted,

Donald D. Jeffery
FOLEY & LARDNER
3000 K Street, N.W.
Suite 500
Washington, D.C. 20007
Telephone: (202) 672-5300

Counsel for Amicus Curiae
National Association of
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